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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robertson, Steven Examiner: Fadok, Mark A.
Serial No.: 9/324,601 Group Art Unit: 3625
Filing Date: 06/02/1999 Attorney Docket: ROBERT.P001
Title of Invention: System and Method for Providing Electronic Multi-Merchant Gift
Certificate and Contribution Brokering Services Over a Distributed
Network

Seattle, Washington 98109
February 15, 2008

TO THE DIRECTOR OF TECHNICAL CENTER 3600
U.S. Patent Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.198

This is a petition under 37 CFR 1.198 to reopen prosecution of this case after both a Decision On Appeal by the Board of Patent Appeals and Interferences (hereafter the Board), and a Decision On Request For Rehearing by the Board, where no court action has been filed by the Applicant.

In the Decision On Appeal dated August 20, 2007, the Board maintained that rejection of claims 23 - 37 was proper because the claims do not include particular limitation(s). The decision reasonably is suggestive that claims including the disclosed limitation would distinguish over the cited art. In addition, a change in grammatical presentation of certain claims was suggested by the Board in the Decision On Request For Rehearing dated January 15, 2008. Again, the decision is reasonably suggestive that claims including the grammatical correction would distinguish over the cited art.

Because Applicant believes that the case is amendable to settlement without the need for going forward with a court proceeding, Applicant hereby petitions the Technology Center 3600

CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR 1.3A)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the United States Patent and Trademark Office on the date shown below to fax number 571 273-8300, to the Director of Technology Center 3600.

February 15, 2008


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1-800-TR-COD

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Director as specified in MPEP 1002.02(c), to reopen prosecution, to consider claim amendments incorporating limitations fairly suggested by the Board as specified in MPEP 1214.07, and to take early favorable action on the claims as now amended.

Claim Amendments

As to Claim 23, in the Board's decision on appeal, page 9, lines 11-16, the Board states:

"The Appellant contends that Gillin teaches away from the elements of claim 23 (Appeal Br. 16; Last Paragraph). The Appellant contends that *a programmatic infrastructure* establishing direct connections to merchants is disclosed and claimed, whereas Gillin requires no relationship with merchants (Appeal Br. 17; First Paragraph). We find no claim limitation regarding a *direct connection to merchants* [between the gift certificate authority site and the merchants redeeming gift certificates] in claim 23 [emphasis and bracketed text added]."

Also, in the Board's decision on appeal, page 11, lines 4-6, the Board states:

"We find that claim 23 contains no limitation of a software module on a merchant site expressly for the purpose of communicating directly with the Gift Certificate Authority Site and server application."

Applicant here presents (see also claim appendix to this petition) independent claim 23, amended as follows to include the limitation above, as suggested by the Board:

23. A system for providing an electronic gift certificate service for users over a distributed network, comprising:

a plurality of ~~merchant sites~~ merchants each having at least one computer server connected to the distributed network, each merchant ~~site~~ computer server running at least one merchant site and at least one server application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a merchant site;

at least one computer server connected to the distributed network, the server running a gift certificate authority site connected to the plurality of merchant sites and a gift certificate authority server application, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants, and a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates, the users accessing the merchant sites from the user computers over the distributed network;

each merchant computer server also running a gift certificate agent, the agent being a client application to the gift certificate authority server application; and

an authentication protocol for allowing the gift certificate site to authenticate users and merchants;

whereby a user purchases on the gift certificate authority site a gift certificate having a unique gift certificate identification code ~~on the gift certificate authority site~~ for use at a merchant site, and a merchant site processes on the gift certificate authority site the gift certificate through ~~the gift certificate database on the direct communication of the gift certificate agent with the gift certificate authority site~~.

By adding as a limitation the disclosed client/server relationship between the gift certificate authority site and the merchant's gift certificate agent, Applicant has added limitations creating the "programmatic infrastructure" and "a software module on a merchant site expressly for the purpose of communicating directly with the Gift Certificate Authority Site" as suggested by the Board. In addition, Applicant has added the explicit limitation that there is "direct communication" between the merchant site and the gift certificate authority site. Since the Board's decision reasonably is suggestive that claims including the limitations now incorporated into these claim amendments would be distinguished over Gillin, Applicant believes these claims would now be allowable. Early favorable action on claim 23 and its dependent claims 24-28 by the Technology Center Director is requested.

Note also, regarding claim 23, that in the Board's Decision on Request for Rehearing, page 2, lines 5-12, the Board states:

"The pertinent issue turns on whether we misapprehended Appellant's issue regarding whether Gillin anticipated the following limitation in claim 23:

[4] whereby.

[a] a user purchases a gift certificate having a unique gift certificate identification code on the gift certificate authority site for use at a merchant site, and

[b] a merchant site processes the gift certificate through the gift certificate database on the gift certificate authority site."

The Board goes on to further explain in the Decision on Request for Rehearing, page 4, lines 3-18:

"However, we note that the Appellant's arguments rely on a construction that is inconsistent with the phrasing of elements [4a] and [4b], and we bring this to the Appellant's attention to advance any further prosecution on the merits. In particular, the Appellant argues that these elements require that actions of purchasing and processing occur on the gift certificate authority site.

This is not how those elements are phrased. Both [4a] and [4b] contain the phrase 'on the gift certificate authority site.' What this phrase modifies in each of [4a] and [4b] according to ordinary grammar is the nearest preceding phrase. The Appellant appears to argue the phrase modifies the preceding verb. The customary reading, by virtue of the proximity between the modifying "on the gift certificate authority site" and preceding phrase in each of [4a] and [4b], would construe element [4a] as requiring that the gift certificate have a unique gift certificate identification code on the gift certificate authority site, and element [4b] as requiring that the gift certificate database be on the gift certificate authority site. The phrase 'on the gift certificate authority site' would not additionally modify the preceding verb in each case."

Therefore, Applicant has further amended claim 23 (as presented above - see final paragraph of claim 23) to clarify the placement of the elements, all as suggested by the Board, and thus creating the intended limitations. Applicant moves the phrase "on the gift certificate authority

site” to a place directly after the verbs it is intended to modify. Hence, it is now clear that in Applicant’s system, a user purchases a gift certificate on the gift certificate authority site and a merchant site processes the gift certificate on the gift certificate authority site, distinguishing the system from any teaching of Gillin’s.

Claims 29-34 are directed to a method for purchasing and redeeming an on-line gift certificate. Applicant here presents independent claim 29, directed to the purchase of the gift certificate, now combined with dependent claim 34, directed to the redemption of the gift certificate (also canceling claim 34 without prejudice), with both claims now amended as follows to include the above limitations as suggested by the Board:

29. A method for a ~~user~~purchaser to purchase a gift certificate from an on-line gift certificate service and for a gift certificate recipient to redeem the gift certificate at a merchant site, the method comprising the steps of:

the online gift certificate service running a gift certificate authority site and a gift certificate authority server application;

~~user~~purchaser enters a desired dollar amount to be applied to the gift certificate;

~~user~~purchaser enters a user-selected personal identification number (PIN) for authentication in a gift certificate redemption process;

~~user~~purchaser provides payment information to the gift certificate site for purchasing the gift certificate;

gift certificate site validates ~~user~~purchaser payment information; and

~~user~~purchaser receives an gift certificate order confirmation, including a unique gift certificate identification code;

~~the merchant site running a gift certificate agent, the agent being a client application to the gift certificate authority server application~~

~~recipient elects gift certificate as form of payment for selected goods or services at merchant site;~~

~~recipient enters unique gift certificate identification code and user selected PIN; and~~

~~the merchant gift certificate agent communicates over distributed network directly with the gift certificate authority server application to authenticate the user gift certificate and complete user purchase of selected goods or services.~~

34. (Canceled)

By distinguishing the generalized term “user” between the term “purchaser” and the term “recipient” in the above claim amendments, it is necessary to proliferate the distinction throughout the dependent claims. Therefore, Applicant here presents claims 30, 31 and 33 amended accordingly:

30. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the ~~user~~purchaser associates a fixed shipping address with the gift certificate.

31. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the ~~user~~purchaser associates a restriction on certificate use, the restriction selected from the group of restrictions consisting of restriction

on certificate use by category of product or service, restriction on certificate use by age range of product or service, restriction on certificate use by dollar limitations on a per order or per item basis, restriction on certificate use by date of use range, and restriction on certificate use to use at selected merchant sites.

33. The method of claim 29 further comprising, in the step of gift certificate order confirmation, the ~~user~~purchaser selectively elects either immediate online display of the order confirmation, or later e-mail notification, or both.

By adding as limitations the disclosed client/server relationship between the gift certificate authority site and the merchant's gift certificate agent, Applicant has added limitations creating the "programmatic infrastructure" and "a software module on a merchant site expressly for the purpose of communicating directly with the Gift Certificate Authority Site" as suggested by the Board. In addition, Applicant has added the explicit limitation that there is "direct communication" between the merchant site and the gift certificate authority site. Since the Board's decision reasonably is suggestive that claims including the limitations now incorporated into these claim amendments would be distinguished over Gillin, Applicant believes these claims would now be allowable. Early favorable action on claims 29-33 by the Technology Center Director is requested.

As to Claim 35, in the Board's decision, page 16, lines 17-23, the Board states:

"As the Examiner found, claim 35 is essentially the same as claim 23 with the word 'beneficiary' replacing 'merchant' and the word 'contribution' replacing the phrase 'gift certificate' ... Since both claims are system claims, the structure is identical and therefore the finding that Gillin anticipates claim 23 necessarily means that it also anticipates claim 35."

Applicant, therefore, here presents independent claim 35, amended as follows to similarly include the above limitations and grammatical corrections, as suggested by the Board for claim 23:

35. A system for providing an electronic contribution service for users over a distributed network, comprising:

a plurality of ~~beneficiary sites~~beneficiaries each having at least one computer server connected to the distributed network, each beneficiary ~~site~~computer server running at least one beneficiary site and at least one server application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a beneficiary site;

at least one computer server connected to the distributed network, the server running a contribution authority site connected to the plurality of beneficiary sites and a contribution authority server application, the contribution site including a user database and a beneficiary database, each database containing authentication information as to respective users and beneficiaries, and a contribution database which stores contribution data and transaction data related to particular contributions, the users accessing the beneficiary sites from the user computers over the distributed network;

each beneficiary computer server also running a contribution agent, the agent being a client application to the contribution authority server application; and an authentication protocol for allowing the contribution site to authenticate users and beneficiaries;

whereby a user makes a contribution on the contribution authority site having a unique contribution identification code on the contribution authority site for use at a beneficiary site, and a beneficiary site processes on the contribution authority site the contribution through the contribution database on direct communication of the contribution agent with the contribution authority site.

By adding as a limitation the disclosed client/server relationship between the contribution authority site and the beneficiary's contribution agent, Applicant has added limitations creating the "programmatic infrastructure" and "a software module ... expressly for the purpose of communicating directly" with the contribution authority site, as suggested by the Board for claim 23 and, therefore, by their further explicit direction for claim 35. In addition, Applicant has added the explicit limitation that there is "direct communication" between the beneficiary site and the contribution authority site. Since the Board's decision reasonably is suggestive that claims including the limitations and grammatical corrections now incorporated into these claim amendments would be distinguished over Gillin, Applicant believes these claims would now be allowable. Early favorable action on claim 35 and dependent claims 36 and 37 by the Technology Center Director is requested.

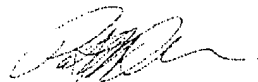
Applicant has amended all claims (dependent claims necessarily incorporating all the limitations of the independent claims from which they depend), and Applicant believes every claim now incorporates every limitation suggested by the Board in both their Decision On Appeal of August 20, 2007 and their Decision On Request For Rehearing on January 15, 2008. As is demonstrated above, both of these decisions are reasonably suggestive that claims including the now added limitations would distinguish over all cited art and, therefore, be allowable. Applicant therefore petitions for the reopening of this case and early favorable action on claims 23-37 as amended.

A copy of the claims as currently amended for presentation in this petition has been included as Appendix I to this petition.

Applicant requests that this petition be speedily granted, and if there are any questions, Applicant requests a call to Patrick Dwyer at (206) 550-4049.

P001-2ndPet1198.wpd

Respectfully submitted,



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APPENDIX I

Claims as amended by this petition (amended from claims as presented to the BPAI in the Appeal brief dated August 28, 2006):

1-22. Cancelled.

23. A system for providing an electronic gift certificate service for users over a distributed network, comprising:

a plurality of ~~merchant sites~~ merchants each having at least one computer server connected to the distributed network, each merchant ~~site~~ computer server running at least one merchant site and at least one server application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a merchant site;

at least one computer server connected to the distributed network, the server running a gift certificate authority site connected to the plurality of merchant sites and a gift certificate authority server application, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants, and a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates, the users accessing the merchant sites from the user computers over the distributed network;

each merchant computer server also running a gift certificate agent, the agent being a client application to the gift certificate authority server application; and

an authentication protocol for allowing the gift certificate site to authenticate users and merchants;

whereby a user purchases on the gift certificate authority site a gift certificate having a unique gift certificate identification code ~~on the gift certificate authority site~~ for use at a merchant site, and a merchant site processes on the gift certificate authority site the gift certificate through ~~the gift certificate database on the direct communication of the gift certificate agent with the gift certificate authority site.~~

24. The system of claim 23, further comprising, during user purchase of a gift certificate, the user placing restrictions on the use of the gift certificate.

25. The system of claim 23, further comprising tracking use of the gift certificate by the user.

26. The system of claim 25, further comprising a search mechanism operatively associated with the gift certificate database that provides access to the user to those sales transactions associated with a particular user gift certificate.

27. The system of claim 23, further comprising user anonymity that is effected by preventing merchant site access to any user related data, other than the gift certificate identification code.

28. The system of claim 23, further comprising, within the gift certificate database, and in conjunction with merchant site processing of the gift certificate through the gift certificate database, splitting of the gift certificate across multiple purchases at a plurality of merchant sites.

29. A method for a user purchaser to purchase a gift certificate from an on-line gift certificate service and for a gift certificate recipient to redeem the gift certificate at a merchant site, the method comprising the steps of:

the online gift certificate service running a gift certificate authority site and a gift certificate authority server application;

user purchaser enters a desired dollar amount to be applied to the gift certificate;

user purchaser enters a user-selected personal identification number (PIN) for authentication in a gift certificate redemption process;

user purchaser provides payment information to the gift certificate site for purchasing the gift certificate;

gift certificate site validates user purchaser payment information; and

user purchaser receives an gift certificate order confirmation, including a unique gift certificate identification code;

the merchant site running a gift certificate agent, the agent being a client application to the gift certificate authority server application;

recipient elects gift certificate as form of payment for selected goods or services at merchant site;

recipient enters unique gift certificate identification code and user selected PIN; and

the merchant gift certificate agent communicates over distributed network directly with the gift certificate authority server application to authenticate the user gift certificate and complete user purchase of selected goods or services.

30. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the ~~user-purchaser~~ associates a fixed shipping address with the gift certificate.

31. The method of claim 29 further comprising, ahead of the step of gift certificate site validation, the ~~user-purchaser~~ associates a restriction on certificate use, the restriction selected from the group of restrictions consisting of restriction on certificate use by category of product or service, restriction on certificate use by age range of product or service, restriction on certificate use by dollar limitations on a per order or per item basis, restriction on certificate use by date of use range, and restriction on certificate use to use at selected merchant sites.

32. The method of claim 31 wherein the restriction on certificate use is a restriction on certificate use by category of product or service.

33. The method of claim 29 further comprising, in the step of gift certificate order confirmation, the ~~user-purchaser~~ selectively elects either immediate online display of the order confirmation, or later e-mail notification, or both.

34. (Canceled)

35. A system for providing an electronic contribution service for users over a distributed network, comprising:

a plurality of ~~beneficiary sites~~ beneficiaries each having at least one computer server connected to the distributed network, each beneficiary ~~site~~ computer server running at least one beneficiary site and at least one server application to provide an online service to users over the distributed network;

a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a beneficiary site;

at least one computer server connected to the distributed network, the server running a contribution authority site connected to the plurality of beneficiary sites and a contribution authority server application, the contribution site including a user database and a beneficiary database, each database containing authentication information as to respective users and

beneficiaries, and a contribution database which stores contribution data and transaction data related to particular contributions, the users accessing the beneficiary sites from the user computers over the distributed network;

each beneficiary computer server also running a contribution agent, the agent being a client application to the contribution authority server application; and

an authentication protocol for allowing the contribution site to authenticate users and beneficiaries;

whereby a user makes a contribution on the contribution authority site having a unique contribution identification code ~~on the contribution authority site~~ for use at a beneficiary site, and a beneficiary site processes on the contribution authority site the contribution through the ~~contribution database on direct communication of the contribution agent with~~ the contribution authority site.

36. The system of claim 35, further comprising, within the contribution database, and in conjunction with beneficiary site processing of the contribution through the contribution database, the contribution is set up to be selectively one-time or recurring automatic.

37. The system of claim 35, further comprising user anonymity that is effected by preventing beneficiary site access to any user related data, other than the contribution identification code.